

This Opinion is Not a
Precedent of the TTAB

Mailed: February 16, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hyundai Motor Company
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Serial No. 88599443
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Charles P. Guarino of Moser Taboada,
for Hyundai Motor Company.

Christina Calloway, Trademark Examining Attorney, Law Office 122,
Kristin Dahling, Managing Attorney.

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Before Lykos, Greenbaum and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Hyundai Motor Company (“Applicant”) seeks registration on the Principal Register of the standard character mark HYUNDAI CARPAY (“Carpay” disclaimed) for (as amended):

Issuance of membership credit cards; mobile internet payment services, namely, rent payment services, bill payment services, credit, debit, prepaid, membership card payment processing services; payment services provided via wireless telecommunications apparatus and devices, namely, rent payment services, bill payment services, credit, debit, prepaid, membership card payment processing services; processing of credit card transactions; processing of payment transactions via the Internet; Membership club services, namely,

providing information to members in the field of financing; providing financial information related to the integration and analysis of account information between vehicles and customers, and transaction information collected through in-vehicle simple payments; in-vehicle transaction verification services, namely, payment verification services, credit, debit, prepaid, membership card payment processing services; in-vehicle mobile and internet payment services, namely, rent payment services, bill payment services, credit, debit, prepaid, membership card payment processing services; in-vehicle automated payment services, namely, rent payment services, bill payment services, credit, debit, prepaid, membership card payment processing services; card services in the nature of credit, debit, prepaid, membership card payment processing services in the field of financing for the accumulation of points and mileage in International Class 36.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the services identified in the application, so resembles the mark CARPAY, registered on the Principal Register for "software as a service (SAAS) services featuring software for facilitating auto loan payments" in International Class 42,² as to be likely to cause confusion, mistake or deception.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

¹ Application Serial No. 88599443 was filed on August 30, 2019, under Trademark Act Sections 1(b) and 44(d), 15 U.S.C. §§ 1051(b) and 1126(d), based upon Applicant's allegation of a bona fide intention to use the mark in commerce; claiming a priority date of June 20, 2019 based on the filing date of Applicant's South Korean application.

² Registration No. 5772963, issued on June 11, 2019.

I. Objection to Materials Appended to Applicant's Brief

Before proceeding to the merits of the refusal, we sustain the Examining Attorney's objection³ to hundreds of pages of materials contemporaneously filed as exhibits with Applicant's Brief, after Applicant appealed. Applicant cites these materials to establish the commercial strength of its HYUNDAI house mark. Applicant further included with its Brief the file histories of now-abandoned applications to register the mark CARPAY filed by an unrelated third party.⁴

The record in an application should be complete before the filing of an appeal, pursuant to Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *see also In re tapio GmbH*, 2020 USPQ2d 11387, at *3-4 (TTAB 2020) (excluding Internet screen shots embedded in the applicant's appeal brief, as well as exhibits and a declaration from the applicant's attorney appended to its brief); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.01 (2021).

Prior to or concurrent with its Notice of Appeal, Applicant had the opportunity to supplement the prosecution record by way of filing a request for reconsideration.

³ Examining Attorney's Brief, 6 TTABVUE 12. Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n. 6 (TTAB 2014). Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

⁴ Applicant's Brief, 4 TTABVUE 22-371.

Trademark Rule 2.63(b)(3), 37 C.F.R. § 2.63(b)(3);⁵ *see also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009) (“A timely request for reconsideration of an appealed action may be accompanied by additional evidence, which will thereby be made part of the evidentiary record in the application.”).

Alternatively, after institution of the appeal but prior to final decision (preferably prior to filing Applicant’s main brief), Applicant could have filed a separately captioned written request for remand to introduce additional evidence based on good cause. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP § 1209.04 (“Requests for remand are generally filed by applicants because they wish to make additional evidence of record”). *See also* TBMP § 1207.02 (“Request to Remand for Additional Evidence”) and cases cited therein. *Cf. In re Ox Paperboard, LLC*, 2020 USPQ2d 10878 , at *1-2 (TTAB 2020) (discussing best practices for an applicant seeking to obviate a refusal by proposing an amendment to the identification of goods in an application, before and after appeal to the Board).

A showing of good cause for remand may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal, and must be accompanied by the additional evidence sought to be introduced. *In re City of Houston*, 101 USPQ2d 1534, 1536 n.5 (TTAB 2012) (evidentiary submissions “should be made prior to appeal or, if after appeal, pursuant to a remand of the matter to the examining attorney for further examination. Trademark Rule 2.142(d).”) (quoting *In*

⁵ Requests for reconsideration must be filed within six months from the issuance of a final Office Action. Trademark Act Section 12(b), 15 U.S.C. § 1052(b); Trademark Rules 2.62(a), 2.63(b)(1)(i), 2.63(b)(3), 37 C.F.R. §§ 2.62(a), 2.63(b)(1)(i), 2.63(b)(3).

re Broadway Chicken Inc., 38 USPQ2d 1559, 1560 n.6 (TTAB 1996) (citing *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

The materials appended to Applicant's Brief that were not made part of the prosecution record are untimely, and we decline to consider them. *In re Taverna Izakaya LLC*, 2021 USPQ2d 1134, at *3 (TTAB 2021).

II. Likelihood of Confusion - Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

Varying weights may be assigned to the various *DuPont* factors depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)) (citations omitted). These and other factors are considered below.

III. Likelihood of Confusion - Analysis

We now consider the arguments of Applicant and the Examining Attorney, the applicable law and the evidence of record regarding likelihood of confusion.

A. The Marks at Issue

In our evaluation of the similarity or dissimilarity of Applicant’s and Registrant’s marks, the first *DuPont* factor, *DuPont*, 177 USPQ at 567, we first consider the strength of Registrant’s CARPAY mark and then compare the respective marks in their entireties.

1. Strength of the Cited Mark

Turning to the strength of Registrant’s CARPAY mark, which affects the scope of protection to which it is entitled, we consider the conceptual strength of Registrant’s

mark, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). The commercial strength of Registrant’s mark also is affected by the number and nature of third-party use of similar marks for similar goods. *DuPont*, 177 USPQ at 567.

As Registrant’s mark is registered on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), it is presumed to be inherently distinctive for “software as a service (SAAS) services featuring software for facilitating auto loan payments.” *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). Nonetheless, Applicant asserts the following arguments in challenging the strength of Registrant’s mark, concluding that “the common term ‘Carpay’ should be deemed highly descriptive in the context of the services covered by the subject Application and the cited mark.”⁶

- The common element between the Applicant’s mark and the cited ‘963 Registration is the term “Carpay,” which is highly descriptive in connection with the parties’ respective car-related payment services (as it is literally the fusion of the terms “car” and “pay”).
- The USPTO has previous[ly] found the term “Carpay” to be merely descriptive with respect to U.S. Application Serial Nos. 87660466 and 87660503 in connection with similar goods and services (citing, as evidence, the application file histories attached to Applicant’s Brief but not made of record during prosecution).
- The Examining Attorney, in the First Office Action, required Applicant to disclaim the term CARPAY, stating that this term was “merely descriptive of

⁶ Applicant’s Brief, 4 TTABVUE 13

an ingredient, quality, characteristic, function, feature, purpose, or use of [A]pplicant's goods and/or services[,]” based solely on the dictionary definitions of the individual words “car” and “pay” made of record.⁷

Applicant's arguments lack merit for a number of reasons. To begin, Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registered mark. During ex parte prosecution, including an ex parte appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (In “an ex parte proceeding, an[] applicant is not permitted to overcome a refusal by arguing that [the mark of] a cited registration is merely descriptive.”); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992) (“Applicant's suggestion that registrant's mark is descriptive may not be considered inasmuch as that allegation comprises an attack on the validity of registrant's registration which is not permitted in an ex parte appeal proceeding.”).

The validity of a cited registration in an ex parte proceeding can only be challenged by an applicant's filing of a petition to cancel. If Applicant had desired to pursue its argument that the CARPAY mark in the cited registration is merely or highly descriptive and that the registration should not bar Applicant's registration, Applicant should have filed a petition to cancel the registration, pleading proper grounds for its entitlement to maintain the claim and the requisite elements of the claim itself. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971)

⁷ Office Action of October 29, 2019, at TSDR 4, 6-10.

(applicant's allegation of priority of use in ex parte proceeding is inappropriate collateral attack on validity of cited registration, which should have been made in formal cancellation proceedings).

Moreover, Applicant provided no evidence that Registrant's CARPAY mark is merely descriptive; the only evidence of record on this point being the dictionary definitions of "Car" and "Pay" that the Examining Attorney submitted with the First Office Action.⁸ As discussed above, the Examining Attorney made these dictionary definitions of record to support the contention that "Carpay" was merely descriptive of Applicant's services (and thus requiring a disclaimer),⁹ not Registrant's services. Even then, the Examining Attorney reconsidered her position in the Second and Final Office Actions, stating that "Carpay" indeed was "registrable matter" in connection with Applicant's services.¹⁰

Applicant's reliance on the USPTO's actions in now-abandoned U.S. Application Serial Nos. 87660466 and 87660503, filed by an unrelated third-party seeking registration of the mark CARPAY, is misplaced. Even if Applicant had timely made the file histories for these applications of record (which it did not), abandoned applications have "no probative value other than as evidence that the applications [were] filed." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049

⁸ Office Action of October 25, 2019, at TSDR 6-10.

⁹ *Id.* at TSDR 4.

¹⁰ Office Action of October 19, 2020, at TSDR 5; Office Action of March 7, 2021, at TSDR 5.

n.4 (TTAB 2002)). Moreover, we are “not bound by a decision of a Trademark Examining Attorney who examined and allowed ... [or refused registration from] application[s] ... [to register] mark[s], based on ... different record[s].” *In re Int’l Watchman, Inc.*, 2021 USPQ2d 1171, *29 (TTAB 2021).

Applicant did not make of record any evidence serving to weaken the inherent or commercial strength of Registrant’s CARPAY mark, such as by making of record relevant third-party registrations or uses. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017). Further, in an ex parte appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016).

We therefore afford Registrant’s CARPAY mark the normal scope of protection to which a registered mark is entitled; it is suggestive.

2. The Similarity or Dissimilarity of the Marks

We determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, the first *DuPont* factor, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB

2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must instead rely upon their recollections, which may be imperfect. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). “The proper test[, therefore,] is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted).

The respective marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, the focus is on the recollection of the average purchaser, here, a consumer who pays bills and makes loan payments (including car loan payments) online, and who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the finding must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751

(Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Further, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

We state the obvious: Applicant’s HYUNDAI CARPAY mark and Registrant’s CARPAY mark share the identical term “CARPAY” – which Applicant calls their “single commonality.”¹¹ Applicant argues that the addition of its “well-known (and arguably famous)” HYUNDAI mark to Registrant’s CARPAY mark is sufficient to distinguish the two.¹²

Because Applicant’s purported proof as to the commercial strength or fame of the HYUNDAI mark was not timely made of record, and (as we noted above) the Examining Attorney objected to such evidence that was untimely filed with

¹¹ Applicant’s Brief, 4 TTABVUE 16.

¹² *Id.* at 12.

Applicant's Brief, we do not consider it. The most we can say of the HYUNDAI mark is that it is inherently distinctive because it does not "consist[] merely of [any] words descriptive of the qualities, ingredients or characteristics of the ... services related to the mark[,]” nor does it “convey[] information regarding a[ny] function, or purpose, or use of the ... [services].” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

Incorporating the entirety of one mark (CARPAY) within another (HYUNDAI CARPAY) typically does not obviate the similarity between the marks, nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See Glamorene Prods. Corp. v. Procter & Gamble Co.*, 538 F.2d 894, 190 USPQ 543, 545-46 (CCPA 1976) (affirming Board's sustaining of opposition against the application to register the mark BOUNCE BACK for a rug cleaning aerosol composition on grounds of likely confusion with the registered mark BOUNCE for dry cleaning detergent.); *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (reversing Board's denial of opposition against the application to register the mark SQUIRT SQUAD for floating water toys on grounds of likely confusion with the registered mark SQUIRT for toy balloons. “The marks SQUIRT and SQUIRT SQUAD are ... of such similarity that they are more likely to create confusion than prevent it. Not only does ... [applicant's] mark SQUIRT SQUAD incorporate the whole of ... [opposer's] mark SQUIRT, but also, in SQUIRT SQUAD, SQUIRT retains its identity.”); *In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (affirming the Board's refusal to register VANTAGE TITAN as likely to be confused with the

registered mark TITAN, stating: “Applicant has taken registrant’s mark and added its ‘product mark’ to it. It is not clear why the addition of the word VANTAGE would avoid confusion. It is more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices.”).

Accepting *arguendo* (without supporting evidence) that HYUNDAI comprises Applicant’s house mark, this case comes within the general rule that the addition of a house mark to a registered mark often is found insufficient to avoid confusion. Doing so “is an aggravation and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor.” *Menendez v. Holt*, 128 U.S. 514, 521 (1888). *See also In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982) (finding likelihood of confusion between the SKIN SAVERS mark for face and throat lotion and the MENNEN SKIN SAVER mark for hand and body lotion; “Where the marks are otherwise virtually the same, the addition of a house mark ... is more likely to add to the likelihood of confusion than to aid to distinguish the marks.”); *In re C.F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976) (affirming refusal to register the mark HATHAWAY GOLF CLASSIC for men’s dress and sport shirts based on the registered mark GOLF CLASSIC for men’s hats:

“[T]he addition of a trade name or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them.”).

“However, there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark. Rather, each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the ... [cited] mark.” *New England Fish Co. v. Herwin Co.*, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975) (BLUE MOUNTAIN KITTY O’s and KITTY, both marks for cat food, not similar).

“Exceptions to this general rule are made when there are some recognizable differences between the assertedly conflicting product marks, so that the addition to one of a trade name or house mark or other such matter may be sufficient to render the marks as a whole distinguishable and thus to avoid confusion, ... or when the ‘product mark’ of an applicant is in fact merely descriptive of the applicant’s goods or services and as such would not be regarded by those who are in the market for such goods or services as an indication of the source thereof ...” *In re C.F. Hathaway Co.*, 190 USPQ at 344. *See also, Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (in which the Board found no likelihood of confusion between the marks NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS, both for women’s clothing, because he shared, registered term ESSENTIALS was found to be highly suggestive based on a dictionary definition and numerous third-party registrations for marks including this term). *See also* TRADEMARK MANUAL OF

EXAMINING PROCEDURE (TMEP) § 1207.01(b)(iii) (2021) (“Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if ... the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.”).

Here we find Applicant’s mark HYUNDAI CARPAY and Registrant’s mark CARPAY to be similar, and the addition of HYUNDAI to Registrant’s CARPAY mark is insufficient to distinguish the marks by the elements of appearance, sound, meaning and overall commercial impression. Were we to find otherwise, allowing registration of the HYUNDAI CARPAY mark over Registrant’s CARPAY mark for the respective services, we would be encouraging a circumstance of reverse confusion – “the situation where a significantly larger or more prominent newcomer ‘saturates the market’ with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services.” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *17 (TTAB 2021) (citing *In re Shell Oil Co.*, 992 F.2d 1204 , 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)).

B. Similarity or Dissimilarity of Services

The second *DuPont* factor considers “[t]he similarity or dissimilarity and nature of the ... services described in an application or registration” 177 USPQ at 567. *See also, Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s

goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”).

The compared services need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) (citing *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the ... [services] in question are different from, and thus not related to, one another in kind, the same ... [services] can be related in the mind of the consuming public as to the origin of the ... [services].”). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that ... [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

To determine the relationship between the services, we are bound by the identifications in Applicant’s involved application and the cited registration. *In re Dixie Rests.*, 41 USPQ2d at 1534 (“Likelihood of confusion must be determined based on an analysis of the marks as applied to the ... services recited in applicant’s application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the... services to be.”) (citing *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)).

The Examining Attorney made of record Internet evidence from several banking, credit and loan financing (including car loan financing) institutions, to show that

Applicant's type of identified services and Registrant's type of identified services are available from the same entities under the same marks:¹³

- JPMorgan Chase Bank, N.A. (Chase) – featuring online one-time and automatic bill, credit card, rent, utilities, loan, mortgage, and equity credit line payment services, and banking services, including by way of a mobile app.
- Ally Financial Inc. (Ally) – featuring online management of one-time and recurring car loan payments, bill payment online account access and banking services, including by way of a mobile app.
- Visa Inc. (Visa) – featuring in-car bill, parking, fuel, mobile transaction and product purchase payments.
- American Honda Finance Corporation (Honda Financial) – featuring online one-time and automatic auto loan payment, car leasing and car financing services.
- Wells Fargo Bank, N.A. (Wells Fargo) – featuring online auto loan account access and payment services, as well as online banking and one-time/automatic bill payment and money transfer services, including by way of a mobile app, credit card services.

Evidence that “a single company sells the ... services of both parties, if presented, is relevant to the relatedness analysis” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Embiid*, 2021 USPQ2d 577, at *22-23 (TTAB 2021) (“Evidence of relatedness may include ... advertisements showing that the relevant ... [services] are advertised together or sold by the same ... [entity]”) (quoting *In re Ox Paperboard*, 2020 USPQ2d 10878, at *5)).

Thus, based on the identifications of services in the HYUNDAI CARPAY application and CARPAY registration and the evidence made of record, we find the respective services are related. The second *DuPont* factor therefore supports a finding that confusion is likely.

¹³ Office Action of October 19, 2020, at TSDR 8-39, 44-63.

C. Similarity or Dissimilarity of Trade Channels and Purchasers

The third *DuPont* factor assesses the similarity or dissimilarity of the parties' established, likely-to-continue trade channels and the class(es) of buyers to whom sales are made. *DuPont*, 177 USPQ at 567. Because the identifications of services in the application and cited registration do not include any restrictions or limitations as to trade channels, we presume the respective services are or would be marketed in all normal trade channels for such services. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). "Even if the ... services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the ... services." *Hewlett-Packard*, 62 USPQ2d at 1004.

Here, the normal trade channels embrace banking, credit and loan financing institutions (including the financing of car loans). The Internet third-party evidence made of record and mentioned above supports our finding as to the third *DuPont* factor, overlapping trade channels and class(es) of buyers (consumers who pay bills and make loan payments including car loan payments online), which in turn supports a finding that confusion is likely.

D. Sales Conditions and Purchaser Sophistication

"The fourth *DuPont* factor considers '[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.'" *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). Applicant contends that,

given the highly specialized and technical nature of the services offered under the respective marks, the purchasers of those services are undoubtedly highly knowledgeable and discerning in their purchasing decisions. The parties' respective services are sophisticated software services used for payments, the purchasers of which are highly knowledgeable with respect to the specific commercial niche to which the services are directed. As such, the services at issue would not normally be encountered by the same purchasers under circumstances that might give rise to the mistaken belief that they emanated from the same source.¹⁴

Applicant does not point to any evidence made of record supporting these contentions, and our review of the record did not find any. Counsel's arguments are not evidence, and we will not rely on them. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.")).

Focusing on the least sophisticated potential customers of the respective services, as we must, we find fourth *DuPont* factor to be neutral. *See Stone Lion*, at 110 USPQ2d at 1163 ("Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'"). However, even were we to consider a greater degree of customer care in purchasing the services in the Application and cited Registration, particularly in the context of such similar marks and related services, this would not render the consumers "immune from trademark confusion." *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1442 (TTAB

¹⁴ Applicant's Brief, 4 TTABVUE 20.

2014); *see also In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar ... [services].”).

The fourth *DuPont* factor, sales conditions and purchaser sophistication, does not support, nor does it detract from, a finding as to whether confusion is likely.

IV. Likelihood of Confusion - Conclusion

The HYUNDAI CARPAY and CARPAY marks, compared in their entireties, are similar in appearance, sound, meaning and overall commercial impression. The addition of “HYUNDAI” to the cited suggestive mark CARPAY mark does not serve to obviate confusion. Because the respective services are related, and neither the Application nor cited Registration contains any restrictions or limitations as to trade channels, we presume the respective services are or would be marketed in all normal trade channels for such services. The Internet third-party banking and loan financing (including car loan financing) institution evidence made of record demonstrates the overlap of trade channels and target customers. We further find sales conditions and customer sophistication comprise a neutral factor in our analysis. Balancing these factors for which there has been evidence and argument, we find that confusion is likely between Applicant’s HYUNDAI CARPAY mark and Registrant’s CARPAY mark in connection with the identified services.

Decision:

The refusal to register Applicant’s HYUNDAI CARPAY mark is affirmed under Trademark Act Section 2(d), on the ground of likelihood of confusion.